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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,812	10/18/2001	Scott A. Boyd	4164-170	1775

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EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
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3713

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DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/035,812

Applicant(s)

BOYD ET AL.

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There does not appear to be requisite and adequate support in the specification for one of ordinary skill in the art to understand how a bonus prize is awarded in relation to a mystery space and the G column.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and those dependent therefrom recite the limitation "the subsets" in line 7. There is insufficient antecedent basis for this limitation in the claim as one of ordinary skill in the art would not be able to understand which subset is currently being referred to. The claims repeatedly use the phrase subset with reference to 1) one or more subsets, 2) a particular subset,

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or 3) one of the subsets. One of ordinary skill in the art would not understand that which is meant by a subset or exactly what each subset is referring to based upon the repeated use of the word without directly linking the language together. Further, one of ordinary skill in the art would not understand what is meant by “the space within a particular subset conforming to a predetermined order.” There is no basis to define this order and an order is not suggested in the language wherein the spaces are placed in the subset. Therefore, one of ordinary skill in the art would not be able to determine what is meant by order. Further, one of ordinary skill in the art would not understand based upon the indefinite nature used to define a subset what is meant by stating the subsets are selected in consecutive or nonconsecutive order.

Claim 5 recites the limitation “one of the spaces corresponds to more the one of the subset of spaces. One of ordinary skill in the art would not understand what is meant by this language based upon the multiple uses of subset, the lack of antecedent basis in the parent claim, and the previous description.

Claim 6 recites the limitation “simultaneous completion of more than one of the subsets in consecutive or nonconsecutive order. One of ordinary skill in the art would not understand what is meant by this language based upon the multiple uses of the word subset, the lack of antecedent basis in the parent claim and the previous description.

Claim 10 and those dependent therefrom recite the limitation “lighting the columns in sequential order in a respective bingo card in response to step (c). One of ordinary skill in the art would not understand how the elements of step (c) cause the columns to light, as there is not a positive linkage among the relationship of the maximum wager and lighting the columns.

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Claim 11, which depends from Claim 10, does not provide the linkage to one of ordinary skill in the art to understand the relationship between step (c) and the lighting of the column.

Claim 12 recites the limitation "mystery space." One of ordinary skill in the art would not understand based upon the art accepted terms for bingo what is meant by this language.

Claim 13 recites the limitation "an award is given when the mystery space is selected at the same time that the G column is lighted." One of ordinary skill in the art would not understand the relationship between the G column and a mystery space as to understand how the combination occurs and awards a bonus prize.

For examination purposes, the claims will be evaluated as best understood by one of ordinary skill in the art.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5-7 and 9 are under 35 U.S.C. 103(a) as being unpatentable over Odom (US Patent No. 6,581,935).

Odom discloses a method of implementing a game on an electronic gaming machine wherein a player places a wager (Column 3, lines 6-8). In response to the wager the processor controls the selection of a first outcome (Column 4, lines 12-15) wherein the selection is in relation to a plurality of spaces organized into a subset with each space corresponding to a particular subset (FIG 1). The subsets run horizontal, vertical, diagonal, and are based on suitable patterns for the play of bingo (Column 4, lines 24-30). This process is continued until all of the numbers have been called at which point the spaces are compared and a bonus prize is awarded if a subset has been completed (Column 4, lines 24-40). Odom does not disclose that the process is required to be repeated until a win but it is within the scope of Odom that if the player does not win, the player may choose to place another wager until the spaces of one of the subsets becomes filled at which time a prize will be awarded.

Regarding claim 2, the spaces are organized into a BINGO card with the order of B then I then N then G then O (FIG 1).

Regarding claim 5, Odom discloses a number of subsets that can be used to achieve a pattern, thus including horizontal, diagonal, coverall, etc. (Column 4, lines 10-40). Thus, some of the spaces correspond to more than one of the subsets.

Regarding claim 6, a bonus prize is awarded for the completion of more than one of the subsets (Table A, Cover All).

Regarding claim 7, this bonus is special for the simultaneous completion of all subsets, thus representing what is known in the art as a coverall (Table A).

Regarding claim 9, Odom does not explicitly disclose the bonus script; however, it is notoriously well known in the art that the software is used to strictly control the bonusing and awards of the gaming machine and it would be known that a script would be used to make sure that the bonusing and awards perform as desired and within the acceptable range for a gaming commission.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odom (US Patent No. 6,581,935) in view of Yoseloff (US Patent No. 6,398,645).

Odom does teach associating a prize with a bingo achieved on the card. However, Odom does not disclose the use of more than one bingo card.

Yoseloff discloses such a feature in a slot machine game. Yoseloff discloses a variant of Bingo in which the player is provided a multiple number of Bingo Cards on the video screen (Abstract). By allowing the player a number of cards, the player feels like they have a better chance of winning. It would therefore be obvious to one of ordinary skill in the art to allow for a multiple number of gaming cards to be displayed in the Odom device as disclosed by Yoseloff. One of ordinary skill in the art would be motivated to make this incorporation in order to provide the player with a greater number of chances in the bonus round, thus enhancing the excitement of the game for the player and giving the player the impression of having a better chance of winning based on the greater number of cards available in the bonus round.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Odom (US Patent No. 6,581,935) in view of Adams (US 2002/0045472).

Odom discloses the player receives a special bonus prize for using maximum bet but Odom does not disclose that bingo can only be called when a maximum bet is received. However, it is notoriously well known in the art, that prizes in games are often only available to a user who placed the maximum bet.

Adams teaches such a concept in disclosing a bingo game for use in a slot machine. The machine can detect if a maximum wager was placed (paragraph 6). Upon detection, a random one of the spaces are chosen (paragraph 6). It would be obvious to one of ordinary skill in the art to allow for the device of Odom to only reward the bonus prize upon the use of a maximum wager, as such a factor is disclosed by Adams and notoriously well known in the art. One of ordinary skill in the art would be motivated to make this incorporation in order to control the return on the machine.

Claims 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams (US 2002/0045472) in view of Yoseloff (US Patent No. 6,398,645).

Adams discloses a method for implementing a bonus game on an electronic gaming machine that comprises the steps of receiving a wager for a base game (paragraph 2). The gaming machine is provided with a bonus feature relating to a bingo game (paragraph 6) wherein the card has five columns that are each associated with a particular B-I-N-G-O letter wherein a plurality of spaces are disposed (FIG 1). The machine can detect if a maximum wager was placed (paragraph 6). Upon detection, a random one of the spaces are chosen (paragraph 6).



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Though explicitly disclosed by Adams, the space axiomatically is lit or marked in some manner within the column in order to show that it has been called. This would also cause the entire column to be lit. The player is then awarded a prize for a completed or winning card (paragraph 7). Though a completed card is not the requirement, it is notoriously well known in the art that a BINGO can be defined in any manner desired and as cover alls are well known, it would be obvious that a cover all layout could be used.

Adams does not disclose the use of multiple cards on one screen. However, Yoseloff discloses such a feature in a slot machine game. Yoseloff discloses a variant of Bingo in which the player is provided a multiple number of Bingo Cards on the video screen (Abstract). By allowing the player a number of cards, the player feels like they have a better chance of winning. It would therefore be obvious to one of ordinary skill in the art to allow for a multiple number of gaming cards to be displayed in the Adams device as disclosed by Yoseloff. One of ordinary skill in the art would be motivated to make this incorporation in order to provide the player with a greater number of chances in the bonus round, thus enhancing the excitement of the game for the player and giving the player the impression of having a better chance of winning based on the greater number of cards available in the bonus round.

Regarding claim 11, the cards are ordered in the form of BINGO and each column is lit in response to a selection of the spaces corresponding to the column. Adams does not disclose lighting the entire column for a called number. However, one of ordinary skill in the art understands that the manner in which a bingo card is used and filled would be a design choice of one of ordinary skill in the art. In the manner claimed, wherein a cover all is the goal, highlighting an entire column based on a single number chosen would be not different by design

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than presenting the player with only five numbers, and thus the size of the matrix and the number of columns or choices presented would be an obvious design choice to one of ordinary skill in the art in an attempt to create a more simplistic game for the player.

Regarding claim 12, though Adams does not disclose a mystery space, it is notoriously well known in the art that a bingo card often includes a free space at the center to the user, thus presenting a form of a mystery as the user will never know what exactly was disposed underneath it originally.

Regarding claim 13, Adams disclosing the prize based upon the amount of time it takes the user to fill the card. Adams does not disclose the exact method for awarding prizes as claimed. However, one of ordinary skill in the art understands the manner in which prizes are awarded from a bingo card would be a design choice of one of ordinary skill in the art. In the manner claimed, it would be obvious to a skilled artisan to award users for a near completion of the card if the mystery space is also filled. One of ordinary skill in the art understands such consolation prizes are typically used in bonus games and thus would be motivated to include such an award in the design of the bingo game.

Regarding claim 14, Adams does not explicitly disclose the bonus script; however, it is notoriously well known in the art that the software is used to strictly control the bonusing and awards of the gaming machine and it would be known that a script would be used to make sure that the bonusing and awards perform as desired and within the acceptable range for a gaming commission.

Regarding claim 15, Adams discloses that a plurality of bonus prizes are associated with the bingo card and the prize is selected from the number of available prizes (paragraph 7).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patent No. 5,393,057:** An electronic gaming device in the bingo format wherein the base game acts with the bingo game to establish the results.

**US Patent No. 4,743,024:** Gaming device wherein a user can play bingo to achieve a number of prizes.

**US Patent No. 5,935,002:** Bingo gaming machine wherein the user is spinning to achieve a bingo situation.

**US Patent No. 5,624,119:** Bingo game wherein a plurality of different options and types are used. There is a game disclosed (GRAPES) wherein there is only a single number required per column to achieve bingo.

**US Patent No. 6,450,884:** Slot machine game with an associated bingo bonus game wherein random numbers are drawn and assigned to the player's bingo card in the bonus game.

**US Patent No. 5,639,088:** Gaming system wherein a bingo card is displayed and a player wins for filling the entire bingo card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.



cmm

August 7, 2003



MICHAEL O'NEILL  
PRIMARY EXAMINER